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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/501,083	07/09/2004	Hirofumi Komiyama	2004-1024a	3115

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WASHINGTON, DC 20006-1021

EXAMINER

SELLERS, ROBERT E

ART UNIT	PAPER NUMBER
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1712

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
31 DAYS	01/10/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/501,083

Applicant(s)

KOMIYAMA, HIROFUMI

Examiner

Robert Sellers

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 July 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-30 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1-30 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
 - 2) ☐ Certified copies of the priority documents have been received in Application No. _____.
 - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>10/8/04 & 5/12/06</u> | 6) <input type="checkbox"/> Other: _____ |

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1. The abstract of the disclosure is objected to because it is not confined to a single paragraph. Correction is required. See MPEP § 608.01(b).

2. This application contains claims directed to more than one species of the generic invention. These species are deemed to lack unity of invention because they are not so linked as to form a single general inventive concept under PCT Rule 13.1.

The species are as follows:

- a) The epoxy resins such as the bisphenol A epoxy resin shown in Example 1 on page 10 of the specification.
- b) The curing agents such as the polyeicosdioic anhydride of Example 1.
- c) The curing accelerators such as the triphenylphosphine of Example 1.
- d) The polyols such as the polyethylene glycol of Example 1.

Elections of single species are required ***within each of items a), b), c) and d)*** ***hereinabove*** to which the claims shall be restricted if no generic claim is finally held to be allowable. The reply must also identify the claims readable on the elected species, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered non-responsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species (MPEP § 809.02(a)).

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Claims 1-30 are generic.

3. The species listed above do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, the species lack the same or corresponding special technical feature. The special technical feature is the blend of epoxy resin and a polyol having a melting point of from 40°C to 110°C.

4. Ono et al. Patent No. 5,206,313 categorized as a X reference in the Supplemental European Search Report filed May 12, 2006 (cols. 7-8, Table 1, Sample No. 10) shows mixtures of a YX4000 crystalline tetramethylbiphenoldiglycidyl ether (col. 6, lines 34-36), a blend of non-crystalline epoxy resins including bisphenol A diglycidyl ethers Epikote 1001 and 1002 (col. 6, lines 48-55), the trimellitic anhydride of instant claims 17-22, an o-cresol novolak resin OCN90 having a softening point of 90°C containing phenolic hydroxyl groups, thereby falling within the claimed polyol having a melting point of from 40°C to 110°C (col. 7, lines 32-34), and a curing accelerator.

5. Kranig et al. Patent No. 5,574,112 cited as an A reference in the International Search Report (ISR) filed July 9, 2004 (col. 4, lines 60-66) shows a powder coating comprising an epoxide group-containing synthetic resin of a glycidyl methacrylate copolymer, a dodecanedioic polymeric anhydride (deemed to be a suitable species of curing agent according to page 4, line 2 of the instant specification) and trimethylolpropane (an acceptable species of polyol as corroborated by page 6, lines 2-3 having a melting point of 59°C).

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6. The claimed curing accelerator is not recited. Japanese Patent No. 11-92628 (Japanese '628, also an A reference in the ISR) teaches a powder coating prepared from an epoxy resin, a curing agent such as an acid anhydride, an inorganic filler, a styrene-butadiene rubber and a curing accelerator. It would have been obvious to incorporate the curing accelerator of Japanese '628 into the powder coating of Kranig et al. in order to decrease the curing time.

Accordingly, the special technical feature does not make a contribution over the prior art of Ono et al. alone and Kranig et al. in view of Japanese '628, thereby validating a holding of lack of unity between the species.

A telephone call was made to Michael R. Davis on January 5, 2007 to request an oral election to the above election of species requirement, but did not result in elections being made.

The reply to this requirement to be complete must include (i) an election of species to be examined even though the requirement be traversed (37 CFR 1.143) and (ii) identification of the claims encompassing the elected species.

The election of species may be made with or without traverse. To reserve a right to petition, the election must be made with traverse. If the reply does not distinctly and specifically point out supposed errors in the election of species requirement, the election shall be treated as an election without traverse.

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Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if one of the inventions is found to be unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C.103(a) of the other species.

7. Japanese Patent No. 61-12762 (CAPLUS abstract, cited as A reference in ISR) shows a powder coating composed of epoxy resins, 2-methylimidazole accelerator (listed on page 4, line 24 of the instant specification) and Epicure DX-171 phenolic resin without a disclosed softening point. Japanese Patent No. 50-40629 reports a powder coating obtained from an epoxy resin and a phenolic hydroxyl groups-terminated polyester possessing a softening point of from 70°C to 150°C without the claimed curing accelerator.

8. Japanese Patent No. 49-32998 and PCT Publication No. WO 86/01216 designated as X references in the Supplemental European Search Report set forth the pre-reaction of an epoxy resin with a polyol which is distinguishable from the claimed non-reacted blend of epoxy resin and polyol.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert Sellers whose telephone number is (571) 272-1093. The examiner can normally be reached on Monday to Friday from 9:30 to 6:00. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

rs
1/5/2007



ROBERT E.L. SELLERS
PRIMARY EXAMINER